



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,006	01/07/2002	Lothar Eggeling	PT 1.1678	7184
23416	7590	10/12/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			FRONDA, CHRISTIAN L	
P O BOX 2207			ART UNIT	
WILMINGTON, DE 19899			PAPER NUMBER	

1652

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

18

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/914,006

Applicant(s)

EGGELING ET AL.

Examiner

Christian L. Fronda

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07/31/2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

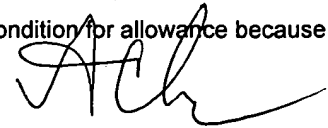
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 14-26, 29-37 and 40.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: signed copy of the 1449 for the IDS dated 07/31/2006.


PONNATHAPU ACHUTHAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000

Continuation of 3. NOTE:

The arguments filed 07/31/2006 have been fully considered does not overcome the rejection of the claims under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated microorganism transformed with a polynucleotide comprising SEQ ID NO: 1 and SEQ ID NO:2, and a method for producing L-valine using said isolated microorganism; does not reasonably provide enablement for any other embodiment as recited in the claims.

The examiner maintains that the specification provides guidance for a dihydroxy acid dehydratase (ilvD) of SEQ ID NO: 2 encoded by SEQ ID NO: 1, ketopantoate hydroxymethyl transferase of SEQ ID NO: 4 encoded by SEQ ID NO: 3, and pantothenate ligase of SEQ ID NO: 5 encoded by SEQ ID NO: 3 from *Corynebacterium glutamicum*. The examiner takes the position that the instant specification only provides guidance for methods for isolating polynucleotides using functional complementation or using known ilvD and ilvBNC (acetohydroxy acid synthase and isomeroreductase) sequences as probes. However, the specification does not provide guidance, prediction, and working examples for the recited species of *Corynebacterium* transformed with any polynucleotide encoding ilvD and/or ilvBNC enzymes other than the above mentioned polynucleotides encoding the enzymes consisting of the amino acid sequences of SEQ ID NO:s 2, 4, and 5, respectively. Thus, an undue amount of trial and error experimentation must be preformed to make the claimed invention. Amending the claims to recite the specific SEQ ID NOs of the recited ilvD and ilvBNC enzymes may overcome the rejection..